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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,632	03/14/2001	Elaine Scott Mason	COS99039	3006
25537	7590	03/13/2006	EXAMINER	
MCI, INC 1133 19TH STREET NW 4TH FLOOR WASHINGTON, DC 20036			GREIMEL, JOCELYN	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/805,632	<b>Applicant(s)</b> MASON, ELAINE SCOTT	
	<b>Examiner</b> Jocelyn W. Greimel	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ( <u>see attachment</u> ). | 6) <input type="checkbox"/> Other: _____  |

Information Disclosure Statements: (08/15/2001), (12/05/2003), (06/23/2004), (01/05/2005), (06/14/2005).

### **DETAILED ACTION**

1. This application is related to, and claims the benefit of the earlier filing date of U.S. Provisional Patent Application (Application No. 60/189,224), filed on March 14, 2000, entitled "Early Payment Discount for E-billing System."

### ***Specification***

2. The specification is objected to because of the following informalities and appropriate action is required:

- a. The last sentence of page 1 is an incomplete sentence.
- b. On page 4 at [10] it appears the word "to" is missing.
- c. On page 4 at [14], a brief description for Figure 3(c) is missing.
- d. On page 6 at [20], the public Internet is labeled "120" and it is labeled "120b" in Figure 1.
- e. On page 9 at [25], "html" is used. For continuity within the document, "HTML" should be used in all cases.
- f. The use of the trademarks MCI, IBM, XEROX, ORACLE and BLUE GILL have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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- g. The Patent Application number is missing on page 10 at [28].
- h. On Figure 4(a), item 412 or the “pay invoice” button appears to be pointing at the incorrect element of the figure.
- i. On Figure 4(a), item 415 or the “pay now” button is missing from the figure.
- j. On page 13 at [33], a reference is made to “BG EBPP” and there is no prior reference to this acronym.
- k. The examiner did not review “Electronic Bill Payment/Presentment Business Practices, Council for Electronic Billing and Payment of the NACHA, June 4, 1999, Edition 1.0, pp. 1-28, entire document” listed on the Information Disclosure Statement filed March 14, 2001 as this edition was not available.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen et al, US Patent No. 6,289,322 (hereinafter Kitchen) and further in view of "Pay and Save" in Accountancy, June 1999 (hereinafter Pay and Save).
5. Regarding claims 1 - 7, Kitchen discloses an e-billing system (col. 3, lines 1-22; col. 5, line 66 – col. 6, line 7), the method and server comprising retrieving invoice information corresponding to a customer (col. 3, lines 9-15; col. 6, lines 29-52), displaying the invoice amount via a web browser (col. 4, lines 37-42; col. 8, lines 4-8), and receiving an input to initiate payment corresponding to the invoice amount via electronic fund transfer (col. 8, line 63 – col. 9, line 8; col. 12, lines 16-48).
6. Kitchen does not disclose calculating a discount amount based on the invoice amount for a pre-defined time from invoice date. However, Pay and Save discloses calculating a discount amount based on the invoice amount for a pre-defined period of time from invoice date (lines 4 – 7). It would be obvious to one of ordinary skill in the art to combine the calculation of a discount amount based on the invoice amount of Pay and Save with the online billing system as disclosed by Kitchen which displays account information and receives payment input. The motivation would be to motivate the customer to pay the invoice earlier to receive the discount and thereby making the money available to the billing entity earlier.
7. Regarding claims 8 - 14, Kitchen discloses a server apparatus for providing an on-line billing system (col. 3, lines 6-8; col. 5, line 66 – col. 6, line 7), the server apparatus comprising a communication interface configured to retrieve customer invoice

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information (col. 3, lines 9-15; col. 6, lines 29-52), a processor coupled to the communication interface and configured to calculate an invoice amount (col. 4, lines 37-42; col. 8, lines 4-8); wherein the communication interface receives an input to initiate payment corresponding to the invoice amount (col. 8, line 63 – col. 9, line 8; col. 12, lines 16-48).

8. Kitchen does not disclose the processor calculating a discount amount based on the invoice amount for a pre-defined time from invoice date. However, Pay and Save discloses calculating a discount amount based on the invoice amount for a pre-defined period of time from invoice date (lines 4 – 7). It would be obvious to one of ordinary skill in the art to combine the calculation of a discount amount based on the invoice amount of Pay and Save with the online billing system as disclosed by Kitchen which displays account information and receives payment input. The motivation would be to motivate the customer to pay the invoice earlier to receive the discount and thereby making the money available to the billing entity earlier.

9. Regarding claims 15 – 21, Kitchen discloses an e-billing system (col. 3, lines 6-8; col. 5, line 66 – column 6, line 7) comprising a database configured to store customer information (col. 6, lines 29-50); a server communicating with the database, the server being configured to retrieve the invoice information from the database (col. 3, lines 9-15; col. 6, lines 29-52), the server being configured to instruct display of the invoice amount via a web browser (col. 4, lines 37-42; col. 8, lines 4-8) and a client communicating with the server, the client being configured to run the web browser and to transmit to the

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server to initiate payment corresponding to the invoice amount (col. 8, line 63 – col. 9, line 8; col. 12, lines 16-48).

10. Kitchen does not disclose the server calculating a discount amount based on the invoice amount for a pre-defined time from invoice date. However, Pay and Save discloses calculating a discount amount based on the invoice amount for a pre-defined period of time from invoice date (lines 4 – 7). It would be obvious to one of ordinary skill in the art to combine the calculation of a discount amount based on the invoice amount of Pay and Save with the online billing system as disclosed by Kitchen which displays account information and receives payment input. The motivation would be to motivate the customer to pay the invoice earlier to receive the discount and thereby making the money available to the billing entity earlier.

11. Regarding claims 22 - 28, Kitchen discloses a server apparatus for providing an on-line billing system (col. 3, lines 6-8; col. 5, line 66 – col. 6, line 7), the server apparatus comprising a communication interface configured to retrieve customer invoice information (col. 3, lines 9-15; col. 6, lines 29-52), a processor coupled to the communication interface and configured to calculate an invoice amount (col. 4, lines 37-42; col. 8, lines 4-8); wherein the communication interface receives an input to initiate payment corresponding to the invoice amount (col. 8, line 63 – col. 9, line 8; col. 12, lines 16-48).

12. Kitchen does not disclose the apparatus calculating a discount amount based on the invoice amount for a pre-defined time from invoice date. However, Pay and Save discloses calculating a discount amount based on the invoice amount for a pre-defined



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period of time from invoice date (lines 4 – 7). It would be obvious to one of ordinary skill in the art to combine the calculation of a discount amount based on the invoice amount of Pay and Save with the online billing system as disclosed by Kitchen which displays account information and receives payment input. The motivation would be to motivate the customer to pay the invoice earlier to receive the discount and thereby making the money available to the billing entity earlier.

13. Regarding claims 29 – 35, Kitchen discloses a computer-readable medium carrying one or more sequences of one or more instructions for providing an on-line billing system, the one or more sequences of one or more instructions including instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of retrieving invoice information corresponding to a customer (col. 3, lines 9-15; column 6, lines 29-52), displaying the invoice amount via a web browser (col. 4, lines 37-42; col. 8, lines 4-8), receiving input to initiate payment corresponding to the invoice amount (col. 8, line 63 – col. 9, line 8; col. 12, lines 16-48).

14. Kitchen does not disclose calculating a discount amount based on the invoice amount for a pre-defined time from invoice date. However, Pay and Save discloses calculating a discount amount based on the invoice amount for a pre-defined period of time from invoice date (lines 4 – 7). It would be obvious to one of ordinary skill in the art to combine the calculation of a discount amount based on the invoice amount of Pay and Save with the online billing system as disclosed by Kitchen which displays account information and receives payment input. The motivation would be to motivate the

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customer to pay the invoice earlier to receive the discount and thereby making the money available to the billing entity earlier.

15. Regarding claims 36 – 42, Kitchen discloses an e-billing system including a computer system accessible for on-line interactive communication of invoices to users (col. 3, lines 6-8, col. 5, line 66 – col. 6, line 7), a computer system comprising a database for storing customer invoice information (col. 3, lines 9-15, col. 6, lines 29-52), the information including an invoice date and total invoice amount (Fig. 9A and Fig. 11), the invoice information displayed to the customer for on-line interaction (col. 4, lines 37-42; col. 8, lines 4-8) and a mechanism for initiating electronic payment of the modified total invoice amount (col. 8, line 63 – col. 9, line 8; col. 12, lines 16-48).

16. Kitchen does not disclose calculating a discount amount based on the invoice amount for a pre-defined time from invoice date. However, Pay and Save discloses calculating a discount amount based on the invoice amount for a pre-defined period of time from invoice date (lines 4 – 7). It would be obvious to one of ordinary skill in the art to combine the calculation of a discount amount based on the invoice amount of Pay and Save with the online billing system as disclosed by Kitchen which displays account information and receives payment input. The motivation would be to motivate the customer to pay the invoice earlier to receive the discount and thereby making the money available to the billing entity earlier.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn W. Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30AM - 4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
HANI M. KAZIMI  
PRIMARY EXAMINER

Jocelyn Greimel  
Examiner  
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